

REMARKS

Claims 1-4 have been amended to more definitely set forth the invention and obviate the rejections. Support for the amendment of Claims 1-4 can be found in the Specification on page 50, last line, page 52, lines 2-4, page 53, lines 15-19, and page 55, second paragraph. The present amendment is believed not to introduce new matter. Claims 1-4 are in the application.

Reconsideration is respectfully requested of the rejection of Claims 1-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response to the Examiner's statements on page 2, paragraph 5, of the instant Office Action, Claims 1-4 have been amended to now claim a kit containing two discreet compositions. It is believed that this amendment clarifies the Examiner's questions on this matter.

With regard to the Examiner's comments on page 2, paragraph 6, of the instant Office Action, the objectionable term "minimized" has been deleted from the claims. Furthermore, with regard to the Examiner's comments in paragraphs 7 and 8, on page 3, of the instant Office Action, the brackets, parentheses, and colons in Claim 1 have been deleted. In addition, Claim 1 has been amended to include the phrase "consisting of".

In view of the above amendments it is believed that the rejection is now moot. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over JP 6-128122 (122) in view of JP 9-194323 (323).

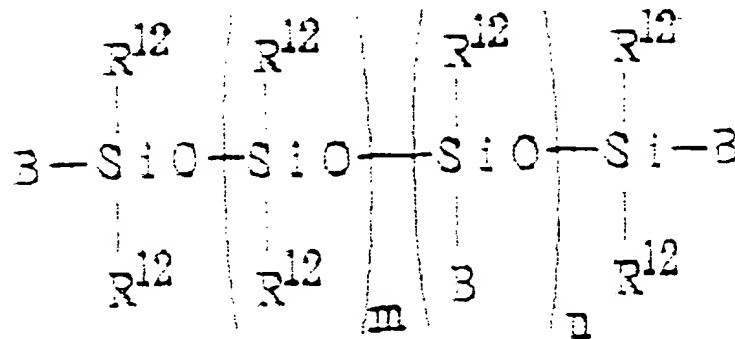
The cited JP '122 reference is directed to makeup compositions comprising a first layer foundation composition and second layer foundation finishing composition. However, as the Examiner has correctly recognized on page 4 of the instant Office Action, the cited JP '122 reference fails to teach a first layer foundation composition containing a polyether modified as silicone, water and a hydrophobic powder in addition to the silicone oil. Furthermore, the cited '122 reference fails to disclose or suggest that limiting a finishing layer containing a reduced amount of reflection powder, such a titanium oxide and mica, to no more than 10 wt% of the finishing layer, provides a natural appearance to the skin while simultaneously allowing the first layer of the multilayer composition to conceal irregularities in the skin. Rather, this teaching comes only from the present invention, and constitutes an important element or aspect thereof.

The cited JP '323 reference teaches a cosmetic composition containing a silicone oil, a polyether-modified silicone of the formula instantly claimed, water and hydrophobic powder, but fails to teach a second layer finishing composition containing 1-100 wt.% of the reflection minimized powder and less than 10 wt.% of the reflection powder, as claimed herein, the combination of which allows a user to achieve the object of the present invention.

In contrast, the present invention provides a kit containing:

- (1) a first layer foundation composition consisting of a composition containing
 - (a) a silicone oil having a viscosity of 15,000,000 cps or less as measured at 25°C and a powder ingredient;
 - (b) a composition containing a siliconated polysaccharide compound, in a silicone oil having a low viscosity and/or a powder ingredient; or

(b) a composition containing i) a silicone oil, ii) a polyether-modified silicone represented by the following formula, iii) water, and iv) hydrophobic powder:



wherein B represents a methyl group, a phenyl group, or a polyoxyalkylene group represented by the formula $C_3H_6O(C_2H_4O)_b(C_3H_6O)_cR^{13}$; R^{13} represents a hydrogen atom, an acyl group, or a C1-C4 alkyl group; each of b and c represents an integer of 5-50; R^{12} represents a methyl group or a phenyl group; m represents an integer of 50-1,000; n represents an integer of 1-40; and the molecule contains at least one polyoxyalkylene group represented by the above formula; and

a second layer finishing composition consisting of a composition containing

(d) a first powder having a regular reflection percentage of 1% or less in an amount of 1-100 wt.%, and

(e) a second powder,

at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5%, in an amount of less than 10 wt.%, on the basis of the entirety of the finishing composition.

Importantly, as mentioned above, the reflection powder incorporated into the second layer of finishing composition is in an amount of 10.0 wt.% or less, as now claimed herein in amended Claim 1. If the reflection powder is contained in an amount of 10.0 wt.% or more on the basis of the entirety of the finishing composition, a powdery or white appearance attributable to the reflection powder occurs, thus defeating one of the objectives of the present invention, i.e., to impart a natural appearance to human skin while simultaneously concealing blemishes thereon (see Specification, page 53).

In conventional multilayer cosmetic compositions, a first layer and a second layer composition are present wherein the first layer composition generally acts merely to adhere the second layer of the composition onto the skin, but does not conceal skin pores. In contrast, in the present invention, it was unexpectedly discovered that while the first layer foundation composition of the multilayer cosmetic composition is able to provide a smooth appearance and correct/conceal blemishes and skin pores, the second layer finishing composition allows application of a thin coating of the first layer foundation composition to the skin to be sufficient for concealment of blemishes and skin pores while, in addition, simultaneously imparting a natural appearance.

Proof of an unexpected improvement can rebut a prima facie case of obviousness. In re Murch, 464 F2d 1051, 175 USPQ 89 (CCPA, 1972). In re Costello, 480 F2d 894, 178 USPQ 290 (CCPA, 1973). The chemical compound and its properties are inseparable. A formula is not the compound nor what is patented. Patentability does not, therefore, depend solely on the similarity of the formula of the claimed compound or that of a prior art compound. The unobviousness of its properties must also be considered. In re Papesch, 315 F2d 381, 137 USPQ 43 (CCPA, 1963); In re

Ward, 329 F2d 1021, 141 USPQ 227 (CCPA, 1964); In re Stemniski, 444 F2d 581, 170 USPQ 343 (CCPA, 1971)

"Synergism" is a very broad term and means "combined action of two or more agents... that is greater than some of the action of one of the agents used alone...". In re Luvisi, et al., 342 F2d 102, 144 USPQ 646 (CCPA, 1965). The evidence should at least demonstrate an effect greater than the sum of the several effects taken separately. Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F2d 804, 10 PQ 2d 1843 (CAFC, 1989). There are undoubtedly many appropriate tests for determining synergism. In each case the facts must be analyzed to determine whether the chosen method as in fact clearly and convincingly demonstrated an unobvious result. Ex parte Quandranti, 26 PQ 2d 1071 (BPAI, 1992).

The present invention provides a cosmetic kit that enables application of a multilayer cosmetic composition onto the skin of a user, wherein the first layer foundation conceals skin blemishes and hides skin pores, while the second finishing layer foundation allows a natural appearance to be realized while still covering said blemishes. It was unexpectedly discovered that a synergistic effect is obtained by the combination of the first layer foundation and the second layer finishing composition, an effect magnified greatly over the effect achieved when using the components alone/separately. To demonstrate these unexpectedly improved and synergistic results using the multilayer cosmetic composition of the present invention, the present inventors conducted a series of comparative tests using twenty panelists, as outlined on page 61 of the Specification. The results of these tests may be found in Tables 2, 4 and 5 on pages 64, 66 and 69 of the Specification.

In particular, the comparative tests shown in Table 2 demonstrate the synergistic

effectiveness of the compositions of the present invention as now claimed in concealing irregularities of the skin while imparting a natural appearance to the skin. The test results shown in Table 4 of the tests comparing the comparative examples 1-3 to the compositions of the present invention (identified as P EX.1-6) clearly demonstrate that the compositions of the present invention provide much improved natural appearance over the compositions of the prior art. However, as shown in Table 4, when using a conventional cosmetic foundation composition with the second layer finishing composition of the present invention applied thereon, concealment of irregularities in the skin is not achievable.

The test results shown in Table 5 demonstrate that when only the first layer foundation composition of the present invention is used, concealment of irregularities in the skin is only improved slightly, and when the comparative first layer foundation composition is used, the effect of concealment of the irregularities in the skin is very poor. Furthermore, when the first layer foundation composition of the present invention and the second layer finishing composition of the comparative examples are used in combination (combinations 6 and 7), concealment of the irregularities in the skin was obtained, but a powdery, unnatural appearance was imparted to the skin. However, it was unexpectedly discovered that when the first layer foundation composition of the present invention, in combination with the second layer finishing composition of the present invention was used simultaneously (combinations 8, 9 and 11), BOTH excellent concealment of the irregularities in the skin was achieved, AND a very natural skin appearance imparted to the user, *i.e.*, *a synergistic effect was obtained by use of the claimed combination of elements herein.*

It is believed that, in view of the legal authorities cited above, the test results clearly

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demonstrate patentability of the presently claimed invention based on unexpected and synergistic results. Therefore, it is believed that the Examiner would now be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

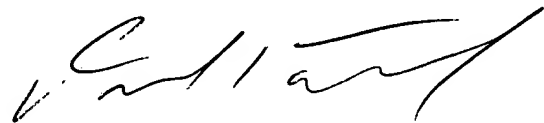
In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

TOWNSEND & BANTA



Donald E. Townsend, Jr.
Reg. No. 43,198



Donald E. Townsend
Reg. No. 22,069

TOWNSEND & BANTA
1225 Eye Street, N.W.
Suite 500, #50028
Washington, D.C. 20005
(202) 682-4727

Date: December 6, 2002

MARKED-UP VERSIONS OF AMENDED CLAIMS 1-4

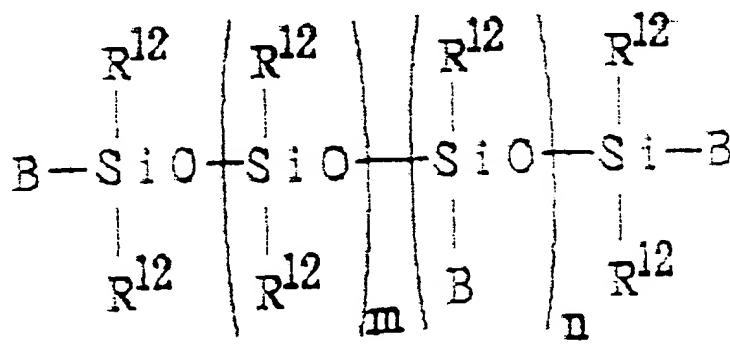
1. (Amended) A [two-layer makeup cosmetic composition comprising] kit containing a first layer foundation composition and a second layer finishing composition, [wherein the first layer foundation composition and the second layer finishing composition are as follows]:

said [the] first layer foundation composition[:] consisting of:

(1) a composition containing a silicone oil having a viscosity of 15,000,000 cps or less as measured at 25°C and a powder ingredient;

(2) a composition containing a siliconated polysaccharide compound, and a silicone oil having a low viscosity and/or a powder ingredient; or

(3) a composition containing i) a silicone oil, ii) a polyether-modified silicone represented by the following formula, iii) water, and iv) hydrophobic powder:



[[] wherein B represents a methyl group, a phenyl group, or a polyoxyalkylene group represented by the formula $C_3H_6O(C_2H_4O)_b(C_3H_6O)_cR^{13}$ [(wherein]; R^{13} represents a hydrogen atom, an acyl group, or a C1-C4 alkyl group; [and] each of b and c represents an integer of 5-50[]]; R^{12} represents a methyl group or a phenyl group; m represents an integer of 50-1,000; n represents an integer of 1-40; and the molecule contains at least one polyoxyalkylene group represented by the above formula[]]; and

[the] said second layer finishing composition[:] consisting of a composition containing a first powder having a [with minimized] regular reflection percentage of 1% or less [and diffuse reflection] in an amount of 1-100 wt.%, and a second powder, at least one of a regular reflection percentage and a diffuse reflection percentage of which is more than 5%, in an amount of less than 10 wt.%, on the basis of the entirety of the finishing composition.

2. (Amended) The [two-layer makeup cosmetic composition] a kit according to claim 1, wherein the first powder of said second layer finishing composition [with minimized regular reflection and diffuse reflection incorporated into the second layer finishing composition] is 10-100 wt.% on the basis of the entirety of the finishing composition.

3. (Amended) The [two-layer makeup cosmetic composition] kit according to claim 1, wherein the first powder [with minimized regular reflection and diffuse reflection has a regular reflection percentage of 1% or less and a diffuse reflection percentage of 1% or less] has a refractive index of 1.3-2.0.

4. (Amended) The [two-layer makeup cosmetic composition] kit according to claim [2] 1, wherein the [powder with minimized regular reflection and diffuse reflection has a regular reflection percentage of 1% or less and a diffuse reflection percentage of 1% or less] first layer foundation composition (3) contains 20.0-80.0 wt.% of silicone oil, 2.0-30.0 wt.% of the polyether modified silicone, 0.2-80.0 wt.% of the water, and 1.0-60.0 wt.% of the hydrophobic powder.